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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,203	12/28/2000	Donald A. Williams	TEL-001	6978

7590 04/20/2004
TELECONOMICO USA INC.
26009 BUDDE ROAD
SUITES B-200/B-300
THE WOODLANDS, TX 77380

EXAMINER

MOORE, IAN N

ART UNIT PAPER NUMBER

2661

DATE MAILED: 04/20/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

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Technology Center 2600

Office Action Summary

Application No.

09/750,203

Applicant(s)

WILLIAMS, DONALD A.

Examiner

Ian N Moore

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claim 6 is objected to because of the following informalities: "...call **my** be connected..."

For consistency, it should be changed to "...call **may** be connected..." Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Ertugrul (U.S. 202/0087645A1).

Regarding Claims 1 and 2, Ertugrul'645 discloses a method for enhancing the use of the Internet (see page 3, paragraph 37; voice-over-IP communication), comprising:

installing software into an Internet connection device (see FIG. 5, **Recipient personal computer**; see page 2, paragraph 11; note that voice-over-IP service is being acquired by the customers (i.e. sender and receiver). Thus, it is clear that recipient computer must be Internet connection computer) to enable said connection device to add a link (see FIG. 2, voice label 204) to an e-mail message (see FIG. 2, e-mail message 200) requesting a recipient of the e-mail (see FIG. 2, a recipient 212) to place a telephone call to

a designated telephone number (see **page 3, paragraph 37; page 1, paragraph 9; note that upon selecting a voice label/button in the e-mail message, the recipient computer will automatically download/install an applet/software in order to initiate/place a voice-over-IP conversation with the designated sender's telephone/modem number**); and

wherein said link includes information to enable the e-mail recipient (see **FIG. 2, a recipient 212**) to download a computer program (see **page 1, paragraph 9; a software package**) into the e-mail recipient's computer (see **FIG. 2, a recipient 212 computer**) to facilitate the placing of said telephone call from the e-mail recipient's computer (see **page 3, paragraph 26; note that the voice label includes the information which cause/enable the recipient computer to download an applet/software to place a voice-over-IP conversation**).

3. Claim 5,7, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Edwards (U.S. 6,502,127).

Regarding Claims 5,7, and 8, Edwards'127 discloses a method of providing communications, comprising:

receiving on a first server (see **FIG. 1, E-mail server 40**) an e-mail transmission from a first Internet connection device originated by a first e-mail user (see **FIG. 1, a message from the first worker A desktop/personal computer 30 which connects to Internet 16; see col. 4, lines 32-33, 37-38**), said e-mail transmission including a link which when displayed on a second Internet connection device (see **FIG. 3C, a call back 326 link displays on e-mail message of the worker B/C; see col. 5, lines 27-29**) enables a second e-

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mail user of said second Internet connection device (see FIG. 1, second worker B/C desktop/personal computer 30 connects to Internet 16; see col. 4, lines 32-33, 37-38) to initiate voice communication between said second Internet connection device and a telephone number specified in said link (see col. 5, lines 36-47; note that when the call back link/button is selected, a voice communication is setup between the desktop computer and the accounting department telephone 25);

transmitting said e-mail message from said first server to an address of said second Internet connection device (see col. 4, lines 40-52; note that e-mail message from the email server 40 is transmitted to the e-mail client 130 of the worker B/C desktop computer 30); and

generating a telephone call (see FIG. 1, by selecting a call back 326 button) from said second Internet connecting device to said telephone number (see col. 5, lines 36-47; note that when the call back link/button is selected it, a voice communication is setup between the worker B/C computer and the accounting department telephone 25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ertugrul'645 in view of Ma (U.S. 6,373,857).

Regarding claim 3, Ertugrul'645 discloses a method of communication utilizing the Internet (see page 3, paragraph 37; voice-over-IP communication), comprising:

receiving on a server (see FIG. 1, **Recipient E-mail Server**) an e-mail message transmitted from a first computer (see FIG. 1, **Sender E-mail client computer**; see page 1, paragraph 9), which email message (see FIG. 2, **e-mail message 200**) includes a request to an intended recipient of the e-mail (see FIG. 2, **a recipient 212 email address**) for a return telephone call (see FIG. 2, **voice label 204**) to a telephone number designated in the e-mail (see page 3, paragraph 37; page 1, paragraph 9; note that the email message contains a voice label/button requesting a recipient computer to initiate/place a phone call with the sender's telephone/modem number);

transmitting said e-mail message to a second computer (see FIG. 1, **Recipient E-mail Client computer**) specified in an address associated with said e-mail message (see FIG. 1, **Recipient E-mail server sends e-mail message to Recipient E-mail client address (i.e. recipient address 212, see FIG. 2)**; see page 3, paragraph 34-35);

a telephone call originated on said second computer may be routed to said telephone number designated in said e-mail message (see page 3, paragraph 26; note that the by selecting a voice label in the email message of the recipient's computer causes the a voice call back to the sender's telephone/modem number).

wherein said link includes information to enable the e-mail recipient (see FIG. 2, **a recipient 212**) to download a computer program (see page 1, paragraph 9; a software

package) into the e-mail recipient's computer (see FIG. 2, a recipient 212 computer) to facilitate the placing of said telephone call from the e-mail recipient's computer (see page 3, paragraph 26; note that the voice label includes the information to cause/enable the recipient computer to download an applet/software to place a voice-over-IP conversation),

Ertugrul'645 does not explicitly disclose including in said e-mail transmission the address of a gatekeeper, said gatekeeper adapted to supply an address of a gateway.

However, the above-mentioned claimed limitations are taught by Ma'857. In particular, Ma'857 teaches transmission of the address of a gatekeeper (see FIG. 1, **Gatekeeper 108 or 109; FIG. 4, step 402-406; note that a gatekeeper address is transmitted**) said gatekeeper adapted to supply an address of a gateway (see FIG. 1, **Gateway 104 or 106; see col. 7, lines 20-44; note that gatekeeper must administer the gateways addresses in order to setup the connection**) through which a telephone call originated on said second computer may be routed to said telephone number (see col. 4, lines 53-62 and col. 5, lines 6-18; note that gateways provides the translations between transmission formats. Thus, it clears that the call between computer terminals 121 and 118 can be routed to telephone 112 via gateways). Also, note that Ertugrul'645 teaches a server connecting between two Internet connection computers to route e-mail message. Ma'857 teaches a requested message includes the gatekeeper address (see Ma'857 col. 7, lines 23-32). Thus, it is clear that Ertugrul'645's email message to the second/recipient computer can include a gatekeeper address so that the recipient can set-up a call with the utilizing appropriate gateway per Ma'857's teachings.

In view of this, having the system of Ertugrul'645 and then given the teaching of Ma'857, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ertugrul'645, by providing a gatekeeper and gateway to set up the call, as taught by Ma'857. The motivation to combine is to obtain the advantages/benefits taught by Ma'857 since Ma'857 states at col. 1, line 65 to col.2, lines 1 that such modification would provide address resolution, call admission control and bandwidth management.

Regarding claim 4, the combined system of Ertugrul'645 and Ma'857 discloses all aspects of the claimed invention set forth in the rejection of Claim 3 as described above, and Ertugrul'645 further teaches wherein authentication information is supplied in the e-mail about the e-mail user sending the e-mail (see **FIG. 3, user table 300, see page 5, paragraph 48-53; note the authentication/security information of the email user is supplied in the email message**). Ma'857 discloses wherein said gatekeeper is further adapted to confirm authentication information supplied in the message (see **col. 4, lines 25-31; note that the gatekeeper performs the administrative and control functions. Thus, it is clear that it must confirm the valid user from the call set up request message before establishing the connection**).

In view of this, having the system of Ertugrul'645 and then given the teaching of Ma'857, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Ertugrul'645, by providing a gatekeeper, as taught by Ma'857, for the same motivation as stated above in Claim 3.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards'127 in view of Ma'857.

Regarding claim 6, Edwards'127 discloses said second Internet connection device generating said telephone call may be connected to said telephone number as described above in claim 5.

Edwards'127 does not explicitly disclose obtaining from a gatekeeper the address of a gateway.

However, the above-mentioned claimed limitations are taught by Ma'857. In particular, Ma'857 teaches the Internet connection device (**see FIG. 1, the calling end points 1112, 116, 118, or 114 device**) obtaining the from a gatekeeper (**see FIG. 1, Gatekeeper 108 or 109**) the address of a gateway (**see FIG. 1, Gateway 104 or 106; FIG. 4, step 402-406; see col. 7, lines 20-44; note that a gatekeeper address is obtained by the endpoint device, and each gatekeeper administers the gateways address in order to setup the connection. Thus, each endpoint obtains the gateway address via a gatekeeper**) through which said telephone call may be connected to said telephone number (**see col. 4, lines 53-62 and col. 5, lines 6-18; the call between computer terminals 121 and 118 can be routed to telephone 112 via gateways**).

In view of this, having the system of Edwards'127 and then given the teaching of Ma'857, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Edwards'127, by providing a gatekeeper and gateway to set up the call, as taught by Ma'857. The motivation to combine is to obtain the

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advantages/benefits taught by Ma'857 since Ma'857 states at col. 1, line 65 to col.2, lines 1
that such modification would provide address resolution, call admission control and
bandwidth management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian N Moore whose telephone number is 703-605-1531. The examiner can normally be reached on M-F: 9-5.

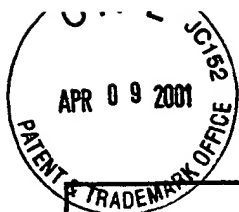
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on 703-305-4798. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

INM
3/31/04



DOUGLAS OLMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



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T.D.S. Delone
Pvt. #15 delone
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#2

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Complete If Known

Application Number	09/750,203
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Filing Date	12/28/2000
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First Named Inventor	Williams, Donald
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Group Art Unit	2661
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Examiner Name _____

Attorney Docket Number	TEL-001
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Sheet

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of

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Donald
APR 11 2001
Group 2600

U.S. PATENT DOCUMENTS

Examiner Initials	Cite No. ¹	U.S. Patent Document		Name of Patentee or Applicant Of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number	Kind Code ² (if known)			
g m	AA	5,526,353		Henley et al.	07-11-1996	
	AB	5,953,322		Kimball	09-14-1999	
	AC	5,991,291		Asai et al.	11-23-1999	
	AD	6,011,794		Mordowitz et al.	01-04-2000	
	AE	6,014,687		Watanabe et al.	01-11-2000	
	AF	6,064,653		Farris	05-16-2000	
	AG	6,069,890		White et al.	05-30-2000	
	AH	6,078,579		Weingarten	06-20-2000	
	AI	6,078,582		Curry et al.	06-20-2000	
	AJ	6,104,704		Buhler et al.	08-15-2000	
	AK	6,108,329		Oyama et al.	08-22-2000	
	AL	6,125,113		Farris et al.	09-26-2000	
	AM	6,138,036		O'Cinneide	10-24-2000	

Examiner
Signature

9m N Pine

Date
Considered

3/30/04



INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Complete If Known	
				Application Number	09/750,203
				Filing Date	12/28/2000
				First Named Inventor	Williams, Don A.
				Group Art Unit	2661
Sheet 2 of 3				Examiner Name	
				Attorney Docket Number	TEL-001

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Group 2660

FOREIGN PATENT DOCUMENTS								
Examiner Initials'	Cite No. ¹	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Office ³	Number ⁴	Kind Code ⁵ (if known)				
			NONE					
Examiner Signature						Date Considered		



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Group 2600

INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Complete If Known	
				Application Number	09/750,203
				Filing Date	12/28/2000
				First Named Inventor	Williams, Donald A.
				Group Art Unit	2661
				Examiner Name	
Sheet	3	of	3	Attorney Docket Number	TEL-001

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, pages, volume-issue numbers(s), publisher, city and/or country where published.	2 T
		NONE	

Examiner Signature		Date Considered	
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Notice of References Cited	Application/Control No. 09/750,203		Applicant(s)/Patent Under Reexamination WILLIAMS, DONALD A.	
	Examiner Ian N Moore		Art Unit 2661	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-2002/0087645 A1	07-2002	Ertugrul et al.	709/206
	B	US-6,502,127 B1	12-2002	Edwards et al.	709/206
	C	US-6,373,857 B1	04-2002	Ma, Patrick SzeChing	370/475
	D	US-6,678,718 B1	01-2004	Khoury et al.	709/204
	E	US-6,243,398 B1	06-2001	Kahane et al.	370/522
	F	US-2003/0123622 A1	07-2003	Gifford et al.	379/88.13
	G	US-6,584,093 B1	06-2003	Salama et al.	370/351
	H	US-6,687,241 B1	02-2004	Goss, Raymond G.	370/352
	I	US-6,014,688 A	01-2000	Venkatraman et al.	709/206
	J	US-2002/0009071 a1	01-2002	YAARY et al.	370/352
	K	US-2002/0131561 a1	09-2002	GIFFORD et al.	379/67.1
	L	US-2003/0123622 A1	07-2003	Gifford et al.	379/88.13
	M	US-2001/0043608 a1	11-2001	POTTER et al.	370/401

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

**NOTICE OF OFFICE PLAN TO CEASE SUPPLYING COPIES OF CITED U.S. PATENT
REFERENCES WITH OFFICE ACTIONS, AND PILOT TO EVALUATE THE
ALTERNATIVE OF PROVIDING ELECTRONIC ACCESS TO SUCH U.S. PATENT
REFERENCES**

Summary

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site (www.USPTO.gov) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

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Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: http://www.uspto.gov/ebc/registration_pair.html.

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at eReference@uspto.gov or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

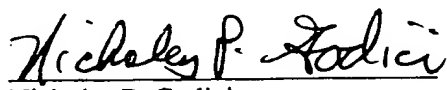
Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at EBC@uspto.gov.

Date. 12/1/03


Nicholas P. Godici
Commissioner for Patents